AP 2154

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: William K. Bodin, *et al.*	§	Group Art Unit: 2154
Serial No.: 10/046,952	§	Examiner: Martin, Nicholas A.
Filed: January 15, 2002	§	Atty Docket No.: AUS920010851US1
Title: Dynamic Indication of Email Capabilities	§	

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December 29, 2005
Date
Catherine Berglund
Catherine Berglund

APPEAL BRIEF

Honorable Commissioner:

This is an Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Final Office Action of August 3, 2005, (hereafter 'the Final Office Action') and pursuant to the Notice of Appeal filed November 1, 2005.

REAL PARTY IN INTEREST

The real party in interest is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1-24 are pending in the case. All pending claims are on appeal.

STATUS OF AMENDMENTS

No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Applicants provide the following concise summary of the claimed subject matter according to 37 CFR § 41.37(c)(1)(v), including references to Applicants provide the following concise summary of the claimed subject matter according to 37 CFR § 41.37(c)(1)(v), including references to the specification by page and line number and to the drawings by reference characters. There are six independent claims in the present case, claims 1, 8, 15, 22, 23, and 24. Claim 1 is a method claim. Claims 8 and 15 claim respectively system and computer program product aspects of the method of claim 1. Claim 1 claims:

1. A method of email administration comprising the steps of:

receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;

finding, in dependence upon the domain identification, at

least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and

sending at least one of the email display capability attributes to the sender.

The means plus function claim elements permitted by 35 U.S.C. § 112, sixth paragraph for independent claim 8 are identified as follows. Note the precise correspondence with the elements of claims 1 and 15:

8. A system of email administration comprising:

means for receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;

means for finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and

means for sending at least one of the email display capability attributes to the sender.

The means plus function claim elements permitted by 35 U.S.C. § 112, sixth paragraph for independent claim 15 are identified as follows. Note the precise correspondence with the elements of claims 1 and 8:

15. A computer program product of email administration comprising:

a recording medium;

means, recorded on the recording medium, **for receiving** in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;

means, recorded on the recording medium, **for finding**, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and

means, recorded on the recording medium, **for sending** at least one of the email display capability attributes to the sender.

The portion of the original specification that is most pertinent to the claims of the present application is pages 30 – 39 and Figures 11 – 16. The subject matter of Claim 1 is summarized as follows with a description beginning at the top of page 30 in the original application. The reference numbers in parenthesis are reference characters of Figure 11. Claims 22, 23, and 24 contain elements parallel to claim 1, so that the following concise summary is applicable also to claims 22, 23, and 24. The acts described in this concise summary of the method of Figure 1 are also the acts corresponding to each claimed function in the means plus functions claimed in claims 8 and 15 according to 35 U.S.C. § 112, sixth paragraph:

> Turning now to Figure 11, an additional exemplary embodiment is shown as a method of email administration that includes **receiving** (1404) in a transcoding gateway (100) from a sender (1402) an email display capability request (1406) for a domain, in which the

capability request includes a domain identification (1409). As used in this specification, "domain" refers to a group of client devices administered together and identified by a common network address, typically an internet protocol address, that resolves to a domain name. Figure 12 illustrates a number of exemplary display capability records (1100) for client devices in two domains (1106), one domain identified by the domain name 'grandma.net,' and the other identified by the domain name 'someother.net.' The display capability records for domain 'someother.net,' that is, records (1170), (1172), and (1174), are included particularly to disclose and explain that a transcoding gateway in many embodiments serves more than one domain. The domain identification (1409 on Figure 11) in various embodiments is implemented as an internet protocol address or as a domain name. In this specification, exemplary domain identifications, for convenience of reference, are generally taken as domain names.

The example embodiment of Figure 11includes **finding** (1414), in dependence upon the domain identification (1409), at least one email display capability record (1100) for the domain, wherein the email display capability record for the domain includes display capability attributes describing an email display capability for the domain. Other example embodiments typically include **sending** (1420) at least one of the email display capability attributes (1418) to the sender. This illustrates embodiments making direct use of domain names (1415) without using a sender identification to find capability records. Such embodiments typically return for sending (1420) back to the sender display capability attributes for all the display capabilities for a domain.

In addition, for clarity of explanation, Applicants provide the following concise summary of the benefits of administering email according to embodiments of the present invention, from the specification beginning at line 8 on page 33:

> This discussion shows the dynamic nature of the exemplary embodiments. Many senders send many emails messages to many domains. Using embodiments of the present invention, however, there is no need to store at the senders' many locations display capabilities for many domains. Using various embodiments of the present invention, display capabilities for a destination domain for a particular email message are made quickly and dynamically available as an email message is being typed in by a sender. Also, display capabilities change from day to day or even from moment to moment in some domains. The domain display capabilities provided through use of embodiments of this invention, however, are timely, representing as they do the exact current availability of display capabilities in a domain.

GROUNDS OF REJECTION

Claims 1-3, 8-10, and 15-17 stand rejected under 35 U.S.C § 102(e) as being anticipated by Tobita, *et al.* (U.S. Pub. No. 2002/0009987 A1). Claims 4-7, 11-14, and 18-21 stand rejected under 35 U.S.C § 103(a) as being anticipated by Tobita, *et al.* (U.S. Pub. No. 2002/0009987 A1) in view of Furukawa, *et al.* (U.S. Pub. No. 2002/0009073 A1).

ARGUMENT

REJECTION UNDER 35 U.S.C § 102(e) OVER TOBITA

Claims 1-3, 8-10, and 15-17 stand rejected under 35 U.S.C § 102(e) as being anticipated by Tobita, *et al.* (U.S. Pub. No. 2002/0009987 A1). To anticipate claims 1-3, 8-10, and

15-17 under 35 U.S.C. § 102(e), two basic requirements must be met. The first requirement of anticipation is that Tobita must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Tobita must enable Applicants' claims. Tobita does not meet either requirement and therefore does not anticipate Applicants' claims.

Tobita Does Not Disclose Each and Every Element Of The Claims Of The Present Application

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As explained in more detail below, Tobita does not disclose each and every element of claim 1, and Tobita therefore cannot be said to anticipate the claims of the present application within the meaning of 35 USV 102.

Independent claim 1 claims:

1. A method of email administration comprising the steps of:

receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;

finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and

sending at least one of the email display capability attributes to the sender.

Claims 8 and 15 claim system and computer program product aspects respectively of the method claimed in claim 1. The Final Office Action at paragraph 19 rejects claim 8 for the same reasons for which claim 1 is rejected. The Final Office Action at paragraph 20 rejects claim 15 for the same reasons for which claim 1 is rejected, adding only a reference to paragraphs 0096-0097 of Tobita. Regarding claim 1, the Final Office Action at numbered paragraph 16 states:

> ...Tobita teaches a method of email administration comprising the steps of:
>
> receiving in a transcoding gateway from a sender an email display capability request [for a domain], wherein the request comprises a domain identification (Paragraphs [0011-0013] and [0020]);
>
> finding at least one email display capability record, wherein the email display capability record comprises display capability attributes describing an email display capability for the domain (Paragraphs [0011-0012]); and
>
> sending at least one of the email display capability attributes to the sender (Paragraphs [0011], [0013] and [0020]).

That is, the Final Office Action takes the position that Tobita as referenced discloses all the elements of claim 1. Applicants respond element-by-element.

The Final Office Action states in paragraph 16 that Tobita at paragraphs 0011-0013 and 0020 discloses "receiving in a transcoding gateway from a sender an email display capability request, wherein the request comprises a domain identification...." That is, the Final Office Action takes the position that Tobita at paragraphs 0011-0013 and 0020 discloses the first element of claim 1. Applicants respectfully note in response, however,

that what Tobita at paragraphs 0011-0013 and 0020 actually discloses is a system made up of mobile phones, a gateway server capable of receiving from the mobile phones "image disclosure requests," and a content server that stores identified images and includes database records that associate image identification with the identity of a user authorized to receive an image. There is not one word in Tobita about email display capability for a domain as claimed in the first element of claim 1 of the present application. On the contrary, Tobita is exclusively concerned with limiting image disclosure to authorized recipients. Tobita does not address communication of domain display abilities at all. Tobita's system and method for image disclosure therefore cannot be said to disclose receiving in a transcoding gateway from a sender an email display capability request for a domain as claimed in the present application.

The Final Office Action states in paragraph 16 that Tobita at paragraphs 0011-0012, discloses "finding at least one email display capability record, wherein the email display capability record comprises display capability attributes describing an email display capability for the domain...." That is, the Final Office Action takes the position that Tobita at paragraphs 0011-0013 and 0020 discloses the second element of claim 1. Applicants respectfully note in response, however, that Tobita at paragraphs 0011-0012, as described above, in fact discloses a system of mobile phones, a gateway, and a content server for controlling access to images. There is not a single word in Tobita's paragraphs 0011-0012 about email display capability records or display capability attributes as claimed in the second element of claim 1 of the present application. Again, Tobita's system and method for image disclosure does not disclose finding at least one email display capability record for the domain as claimed in the present application.

The Final Office Action at paragraph 16 states that Tobita at paragraphs 0011, 0013, and 0020, discloses "sending at least one of the email display capability attributes to the sender...." That is, the Final Office Action takes the position that Tobita at paragraphs 0011, 0013, and 0020 discloses the third element of claim 1. Applicants respectfully note in response, however, that Tobita at paragraphs 0011, 0013, 0020, actually discloses the system of mobile phones, a gateway, and a content server for controlling access to images

described above. The attributes transmitted in Tobita are attributes of images, not display attributes of a domain as claimed here. In fact, there is not one word in Tobita regarding display attributes of a domain. Tobita's system of mobile phones, a gateway, and a content server for controlling access to images therefore cannot be said to disclose sending an email display capability attribute to a sender as claimed in the present application.

In rejecting claim 15, the Final Office Action at paragraph 20 cites the same arguments mentioned above in rejecting claims 1 and 8. The Final Office Action further states that Tobita at paragraphs 0096 and 0097 discloses a recording medium. Claim 15 claims:

> 15. A computer program product of email administration comprising:
>
> a recording medium;
>
> means, recorded on the recording medium, for receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;
>
> means, recorded on the recording medium, for finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and
>
> means, recorded on the recording medium, for sending at least one of the email display capability attributes to the sender.

That is, claim 15 claims a computer program product that comprises a recording medium upon which is recorded means for carrying out the method elements claimed in claim 1 of the present application, and the Final Office Action takes the position that Tobita at paragraphs 0096-0097 discloses a recording medium upon which is recorded steps for carrying out the method of Tobita. Applicants respectfully submit in response that Tobita at paragraphs 0096 and 0097 actually discloses that "[n]umeral 53 represents a hard disk that stores a user identifier list table." That is, Tobita's hard disk stores a user identifier list, ordinary data elements, not a computer program product. Tobita's hard disk that stores a user identifier list table therefore cannot be said to disclose a computer program product that comprises a recording medium upon which is recorded means for carrying out an inventive method as claimed in the present application.

Applicants argue also regarding Tobita that the subject matter of Tobita itself makes it plain that it is simply impossible that Tobita might disclose email administration as claimed in the present application. Tobita is concerned entirely with security measures for controlling downloads of graphic images, determining that the person doing the download is authorized to do the download, and determining that copyright measures are correctly enforced, and so on. There is absolutely nothing in Tobita that addresses the kind of communications regarding display capabilities of a domain for display of email that is the focus of the independent claims in the present application. Tobita simply has nothing to do with email administration as claimed in the present application. As further evidence of this fact, consider that none of the following terms (or variations of them) from the independent claims of the present application occurs in Tobita, not even once:

- email administration
- electronic mail administration
- transcode
- transcoding
- transcoding gateway
- display capability

- email display capability
- display capability request
- email display capability request
- display capability record
- email display capability record
- display capability attributes
- domain
- domain identification
- display capability for a domain
- email display capability for a domain

Independent claims 22, 23, and 24 were added during prosecution in an attempt to move the case forward. Claims 22, 23, and 24 are rejected in paragraphs 41 – 43 of the Final Office Action for the same reasons as claims 1, 4, 5, and 6 on the grounds that claims 22, 23, and 24 respectively do not "teach or define any new limitations" above those claims. Applicants respond with respect that claims 4, 5, and 6 depend from claim 1 and therefore stand if claim 1 stands. Claims 22, 23, and 24 (which define no limitations beyond claims 4, 5, and 6) stand if claims 4, 5, and 6 stand. Claim 1 stands for the reasons set forth above. Therefore claims 4, 5, and 6 stand. Therefore claims 22, 23, and 24 stand also.

As explained here, Tobita does not disclose each and every element of claims 1, 8, and 15. Dependent claims 2-3, 9-10, and 16-17 depend respectively from independent claims 1, 8, and 15. These dependent claims include each and every limitation of the independent claims from which they depend. These dependent claims stand because their respective independent claims stand. The rejections of all claims 1-3, 8-10, and 15-17 under 35 U.S.C. § 102, therefore, should be withdrawn. Applicants respectfully traverse the rejection to each of claims 1-3, 8-10, and 15-17 and request claims 1-3, 8-10, and 15-17 be allowed. For the same reasons, Applicants also respectfully traverse the rejections of claims 22, 23, and 24 and request that claims 22, 23, and 24 be allowed also.

Tobita Does Not Enable Each and Every Element
Of The Claims Of The Present Application

Not only must Tobita disclose each and every element of the claims 1-3, 8-10, and 15-17 of the present application within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Tobita must be an enabling disclosure of each and every element of claims 1-3, 8-10, and 15-17 of the present application within the meaning of *In re Hoeksema.* In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d at 273, 158 USPQ at 600. The meaning of Hoeksema for the present case is that unless Tobita places Applicants' claims 1-3, 8-10, and 15-17 in the possession of a person of ordinary skill in the art, Tobita is legally insufficient to anticipate Applicants' claims under 35 U.S.C. § 102(e).

The Final Office Action states in paragraph 16 that Tobita at paragraphs 0011-0013 and 0020 discloses "receiving in a transcoding gateway from a sender an email display capability request, wherein the request comprises a domain identification...." That is, the Final Office Action takes the position that Tobita at paragraphs 0011-0013 and 0020 discloses the first element of claim 1. Applicants respectfully note in response, however, that what Tobita at paragraphs 0011-0013 and 0020 actually discloses is a system made up of mobile phones, a gateway server capable of receiving from the mobile phones "image disclosure requests," and a content server that stores identified images and includes database records that associate image identification with the identity of a user authorized to receive an image. There is not one word in Tobita about email display capability for a domain as claimed in the first element of claim 1 of the present application. On the contrary, Tobita is exclusively concerned with limiting image

disclosure to authorized recipients. Tobita does not address communication of domain display abilities at all. Tobita's system and method for image disclosure therefore cannot be said to place in the possession of a person of skill in the art receiving in a transcoding gateway from a sender an email display capability request for a domain as claimed in the present application.

The Final Office Action states in paragraph 16 that Tobita at paragraphs 0011-0012, discloses "finding at least one email display capability record, wherein the email display capability record comprises display capability attributes describing an email display capability for the domain...." That is, the Final Office Action takes the position that Tobita at paragraphs 0011-0013 and 0020 discloses the second element of claim 1. Applicants respectfully note in response, however, that Tobita at paragraphs 0011-0012, as described above, in fact discloses a system of mobile phones, a gateway, and a content server for controlling access to images. There is not a single word in Tobita's paragraphs 0011-0012 about email display capability records or display capability attributes as claimed in the second element of claim 1 of the present application. Again, Tobita's system and method for image disclosure does not place in the possession of a person of skill in the art finding at least one email display capability record for the domain as claimed in the present application.

The Final Office Action at paragraph 16 states that Tobita at paragraphs 0011, 0013, and 0020, discloses "sending at least one of the email display capability attributes to the sender...." That is, the Final Office Action takes the position that Tobita at paragraphs 0011, 0013, and 0020 discloses the third element of claim 1. Applicants respectfully note in response, however, that Tobita at paragraphs 0011, 0013, 0020, actually discloses the system of mobile phones, a gateway, and a content server for controlling access to images described above. The attributes transmitted in Tobita are attributes of images, not display attributes of a domain as claimed here. In fact, there is not one word in Tobita regarding display attributes of a domain. Tobita's system of mobile phones, a gateway, and a content server for controlling access to images therefore cannot be said to place in the

possession of a person of skill in the art sending an email display capability attribute to a sender as claimed in the present application.

In rejecting claim 15, the Final Office Action at paragraph 20 cites the same arguments mentioned above in rejecting claims 1 and 8. The Final Office Action further states that Tobita at paragraphs 0096 and 0097 discloses a recording medium. Claim 15 claims:

> 15. A computer program product of email administration comprising:
>
> a recording medium;
>
> means, recorded on the recording medium, for receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;
>
> means, recorded on the recording medium, for finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and
>
> means, recorded on the recording medium, for sending at least one of the email display capability attributes to the sender.

That is, claim 15 claims a computer program product that comprises a recording medium upon which is recorded means for carrying out the method elements claimed in claim 1 of the present application, and the Final Office Action takes the position that Tobita at

paragraphs 0096-0097 discloses a recording medium upon which is recorded steps for carrying out the method of Tobita. Applicants respectfully submit in response that Tobita at paragraphs 0096 and 0097 actually discloses that "[n]umeral 53 represents a hard disk that stores a user identifier list table." That is, Tobita's hard disk stores a user identifier list, ordinary data elements, not a computer program product. Tobita's hard disk that stores a user identifier list table therefore cannot be said to place in the possession of a person of skill in the art a computer program product that comprises a recording medium upon which is recorded means for carrying out an inventive method as claimed in the present application.

Applicants argue also regarding Tobita that the subject matter of Tobita itself makes it plain that it is simply impossible that Tobita might place in the possession of a person of skill in the art email administration as claimed in the present application. Tobita is concerned entirely with security measures for controlling downloads of graphic images, determining that the person doing the download is authorized to do the download, and determining that copyright measures are correctly enforced, and so on. There is absolutely nothing in Tobita that addresses the kind of communications regarding display capabilities of a domain for display of email that is the focus of the independent claims in the present application. Tobita simply has nothing to do with email administration as claimed in the present application. As further evidence of this fact, consider that none of the following terms (or variations of them) from the independent claims of the present application occurs in Tobita, not even once:

- email administration
- electronic mail administration
- transcode
- transcoding
- transcoding gateway
- display capability
- email display capability
- display capability request

- email display capability request
- display capability record
- email display capability record
- display capability attributes
- domain
- domain identification
- display capability for a domain
- email display capability for a domain

Tobita fails to place in the possession of a person of skill in the art each and every element of claims 1, 8, and 15. Dependent claims 2-3, 9-10, and 16-17 depend respectively from independent claims 1, 8, and 15. These dependent claims include each and every limitation of the independent claims from which they depend. These dependent claims stand because their respective independent claims stand. The rejections of all claims 1-3, 8-10, and 15-17 under 35 U.S.C. § 102, therefore, should be withdrawn. Applicants respectfully traverse the rejection to each of claims 1-3, 8-10, and 15-17 and request claims 1-3, 8-10, and 15-17 be allowed. Applicants also note for the same reasons noted above that Tobita also fails to place in the possession of a person of skill in the art each and every element of claims 22, 23, and 24. For the same reasons, therefore, Applicants respectfully traverse the rejections of claims 22, 23, and 24 and request that claims 22, 23, and 24 be allowed.

Because Tobita neither discloses each and every element of Applicants' claims nor enables Applicants' claims, Tobita cannot anticipate Applicants' claims. Claims 1-3, 8-10, 15-17, 22, 23, and 24 are therefore patentable and should be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 4-7, 11-14, and 18-21 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Tobita, *et al.* (U.S. Pub. No. 2002/0009987A1) in view of Furukawa, *et al.* (U.S. Pub. No. 2002/0009073A1). As will be shown below, neither

Tobita nor Furukawa, either alone or in combination, teaches or suggests a method, system, or computer program product for administering devices as claimed in the present application. Claims 4-7, 11-14, and 18-21 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 4-7, 11-14, and 18-21.

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Tobita and Furukawa

Claims 4-7, 11-14, and 18-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Tobita in view of Furukawa. The proposed combination of Tobita and Furukawa cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Combination Of Tobita and Furukawa
Does Not Teach all Of Applicants' Claim Limitation

Because as shown above, Tobita fails to disclose any element of claims 1, 8, and 15, the combination of Tobita and Furukawa also fails to disclose each and every element of dependent claims 4-7, 11-14, and 18-21. Claims 4-7, 11-14, and 18-21 depend respectively from claims 1, 8, and 15. Claims 4-7, 11-14, and 18-21 therefore include all the limitations of claims 1, 8, and 15 which, as shown above, are not disclosed by Tobita. Because the Final Office Action cites Furukawa as teaching only additional claim limitations of dependent claims 4-7, 11-14, and 18-21, that is, limitations in addition to the limitations of the independent claims, the combination of Tobita and Furukawa cannot disclose each and every element of the referenced dependent claims because Tobita does not disclose or enable the limitations of the independent claims for the reasons set forth above. Claims 4-7, 11-14, and 18-21 are therefore patentable and the rejections under 35 U.S.C. § 103 should be withdrawn.

No Suggestion or Motivation to Combine Tobita and Furukawa

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Tobita and Furukawa. *In re Vaeck*, 947 F.2d at 493, 20 USPQ2d at 1442. The suggestion or motivation to combine Tobita and Furukawa must come from the teaching of the references themselves, and the Examiner must explicitly point to the teaching within Tobita or Furukawa suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko,* 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck,* 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman,* 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond,* 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski,* 871 F,.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Final Office Action makes no mention whatsoever of any place in either of the references that suggests or provides any motivation for the proposed combination of Tobita or Furukawa. In paragraph 13, The Final Office Action cites a rule from In re McLaughlin regarding motivation to combine, but the Final Office Action in paragraph 13 merely states the rule, making no attempt to actually provide any motivation to combine.

In addition, in paragraph 26, 30, 34, and 38, the Final Office Action apparently attempts to provide some motivation to combine by stating, "It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Furukawa and Tobita because they both deal with transferring data over a network involving a communication connection." Applicants note in response, however, that this is a mere naked assertion for which no basis is provided from the art, neither from Furukawa, Tobita, nor anywhere else. Moreover, the fact that two references deal with data transfer over a network connection, in this day and age when many thousands of references deal with data transfer over a network connection, cannot possible be said to be sufficient motivation to combine any two particular references.

Further in paragraph 26, 30, 34, and 38, the Final Office Action apparently attempts again to provide some motivation to combine by stating that attributes of Furukawa "... would improve functionality of Tobita's system by allowing for digital data to also be transferred between terminals, which increases the system's versatility in dealing with transmission of data." Applicants note in response that the element of digital data transferred between terminals is already present in Tobita where data is transferred among a multiplicity of mobile phones, gateways, and content servers, so that the addition of this feature cannot possible provide any basis for combining these two references – to provide to Tobita a feature that Tobita already possesses. Applicants note in addition that this too is a mere naked assertion for which no basis is provided from the art, neither from Furukawa, Tobita, nor anywhere else.

The Final Office Action makes no mention whatsoever of any place in either of the references or anywhere else in the art that suggests or provides any motivation for the proposed combination of Tobita or Furukawa. Absent such a showing, the Examiner has impermissibly used hindsight occasioned by Applicants' own teaching to reject the claims. Because the Final Office Action fails to make a prima facie case for obviousness under 35 U.S.C. § 103, the rejections of claims 4-7, 11-14, and 18-21 are improper and should be withdrawn.

No Reasonable Expectation of Success in the Proposed Combination of Tobita and Furukawa

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Tobita. *In re Merck & Co., Inc.,* 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The Final Office Action fails to demonstrate any basis for any reasonable expectation of success in the proposed combination of Tobita and Furukawa. In fact, the Final Office Action makes no mention whatsoever of reasonable expectation of success in the combination.

Moreover, it is not possible to demonstrate any reasonable expectation of success in the proposed combination of Tobita and Furukawa. Tobita, as shown at paragraph 0002, generally discloses a system and method for protecting copyrights that prevents images from being disclosed to more than a predetermined number of persons allowed. Furukawa, as shown in paragraph 0002, generally discloses a method for terminal-to-terminal communication connection control using an IP transfer network. There can be no reasonable expectation of success in Tobita's system for protecting copyrights by regulating the disclosure of images with Furukawa's method for terminal-to-terminal communications using an IP transfer network because it is not functional to graft an affirmative terminal-to-terminal communications function onto a system for exclusion, a system designed to prevent certain communications of graphic images. The two cannot possibly be said to be compatible. The Final Office Action therefore not only does not assert any reasonable possibility of success in its proposed combination, the Final Office

Action could not possibly make any such assertion. Because the Final Office Action demonstrates no reasonable expectation of success in the proposed combination of Tobita and Furukawa, the combination cannot be used as a foundation for a rejection under 35 U.S.C. § 103.

Neither Tobita nor Tobita combined with Furukawa discloses each and every element of claims 4-7, 11-14, and 18-21. There is no suggestion to combine Tobita and Furukawa in either reference, and there is no reasonable expectation of success in the proposed combination. The Final Office Action therefore does not establish a prima facie case of obviousness under 35 U.S.C. § 103. Applicants respectfully traverse the rejection to each of claims 4-7, 11-14, and 18-21 and request that claims 4-7, 11-14, and 18-21 be allowed.

Relations Among Claims

Independent claims 8 and 15 claim system and computer program product aspects of the method claimed in claim 1. Claims 8 and 15 therefore are patentable for the same reasons that claim 1 is patentable as described above. Dependent claims 2-7, 9-14, and 16-21 depend respectively from independent claims 1, 8, and 15. The dependent claims include each and every limitation of the independent claims from which they depend. The independent claims stand because their respective independent claims stand.

The Four Factual Inquires Required By The Supreme Court For An Obviousness Rejection Have Not Been Properly Considered, Determined, And Applied

Establishing a prima facie case of obviousness for claims 4-7, 11-14, and 18-21, which has not been accomplished, is not the end of obviousness analysis, it is the beginning. The rejection of claims 4-7, 11-14, and 18-21 under 35 U.S.C. § 103 is deficient because the proper factual inquiries have not been considered, determined, and applied as required by the Supreme Court in *Graham v. John Deere.* The rejection should therefore be withdrawn and the case allowed.

The Manual of Patent Examining Procedure §2141 states:

> Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:
>
> > Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy. . .
> >
> > This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that

> uniformity and definitiveness which Congress called for in the 1952 Act.
>
> Office policy has consistently been to follow Graham v. John Deere Co. in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquires enunciated therein as a background for determining obviousness are briefly as follows:
>
> (A) Determining of the scope and contents of the prior art;
>
> (B) Ascertaining the differences between the prior art and the claims in issue;
>
> (C) Resolving the level of ordinary skill in the pertinent art; and
>
> (D) Evaluating evidence of secondary considerations.

There is no evidence of secondary considerations in the present case. In almost four years of prosecution, however, the Examiner has yet to even mention the remaining three factual inquiries required by the Supreme Court in *Graham v. John Deere,* and none of the factual inquires has been properly considered, determined, and applied in any of the Office Actions in this case.

The first factual inquiry that has not been properly considered and determined is determining of the scope and contents of the prior art. Applicants point out, with respect, that the Office Actions in this case have consistently referred to the art in a conclusionary manner, making no express attempt to determine the scope and content of the art. That is, the Office Actions quote a claim element and then simply recite that Tobita or Furukawa discloses the claim element with a reference to a paragraph is Tobita or Furukawa, but the Office Actions never make any express determination of the scope of the prior art. Applicants note that a proper determination of the scope and content of the art could

never present Tobita or Furukawa as a reference in the present case, for example. Even a relatively casual examination of Tobita and Furukawa show that they have nothing to do with email administration as claimed in the present case. Tobita is an image security case, and Furukawa is an IP telephony case. At any rate, there is no mention in any of the Office Actions in this case of any express determination of the scope and content of the prior art.

The second factual inquiry that has not been properly considered and determined is ascertaining the differences between the prior art and the claims in issue. More particularly, in each Final Office Action, the Examiner has only identified elements in Applicants' claims not found in Tobita and then attempted to find a similar element in Furukawa to support an obviousness rejection. Such analysis is improper and incomplete. "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole." MPEP §2141.02. Furthermore, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *Id.,* citing *Stratoflex, Inc. v. Aeroquip Corp.,* 713 F.2d 1530 (Fed. Cir. 1983). The Final Office Actions of February 10, 2005, and August 3, 2005, are deficient because the Examiner has only identified differences between certain elements of Applicants' claims and Tobita. This analysis in improper and incomplete because Examiner has not determined whether Applicants claims as a whole would have been obvious in view of the modification of Tobita according to Furukawa and why the claims as a whole would have been obvious. As such, the obviousness rejections should be withdrawn and the case should be allowed.

The third factual inquiry that has not been properly considered, determined, and applied is resolving the level of ordinary skill in the pertinent art. "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." MPEP §2141.03 citing *Ryko Mfg. Co. v. Nu-Star, Inc.,* 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). "The examiner must ascertain what

would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.,* 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). "Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Id. c*iting *Environmental Designs, Ltd. v. Union Oil Co.,* 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). The Office Actions of February 10, 2005, and August 3, 2005, fail to apply a single factor used to determine the level of ordinary skill in the art. In fact, in over three years of prosecution and in two Office Actions, no analysis at all considering the level of one of ordinary skill in the art for the instant case has been performed. The rejection of claims 4-7, 11-14, and 18-21 is therefore deficient and the case should be allowed.

Conclusion

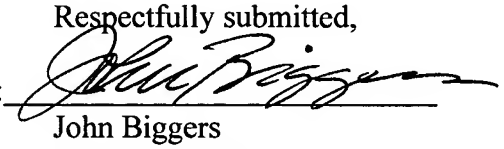
Claims 1-3, 8-10, and 15-17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tobita, *et al.* (U.S. Pub. No. 2002/0009987 A1). Regarding independent claims 1, 8, and 15, Tobita neither discloses each and every element of Applicants' claims nor enables Applicants' claims. Tobita therefore does not anticipate Applicants' claims. Dependent claims 2-3, 9-10, and 16-17 depend respectively from independent claims 1, 8, and 15. Dependent claims 2-3, 9-10, and 16-17 include each and every limitation of the independent claims from which they depend. Dependent claims 2-3, 9-10, and 16-17 stand because their respective independent claims stand. Claims 4-7, 11-14, and 18-21 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Tobita, *et al.* (U.S. Pub. No. 2002/0009987 A1) in view of Furukawa, *et al.* (U.S. Pub. No. 2002/0009073 A1). Neither Tobita nor Tobita combined with Furukawa establishes a prima facie case of obviousness. The rejection of all claims 1-21 should be withdrawn, and all claims 1-21 should be allowed. Claims 22, 23, and 24 are rejected on the same

grounds as claims 1, 4, 5, and 6, and therefore claims 22, 23, and 24 should be allowed for the same reasons as claims 1, 4, 5, and 6. Applicants respectfully traverse each rejection individually of claims 1-24 and request reconsideration of claims 1-24 in light of the present remarks.

In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 9-0447 for any fees required or overpaid.

Respectfully submitted,

Date: December 29, 2005 By: 

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APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
WILLIAM K. BODIN, *ET AL.*, SERIAL NO. 10/046,952

CLAIMS

What is claimed is:

1. A method of email administration comprising the steps of:

receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;

finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and

sending at least one of the email display capability attributes to the sender.

2. The method of claim 1 wherein the email display capability request includes a sender identification identifying the sender, and the method further comprises determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain.

3. The method of claim 2 wherein determining that the sender is authorized to send email to a connection address in the domain further comprises finding, in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record, wherein:

the sender authorization record represents authorization for the sender to send email to a connection address in the domain;

the sender authorization record comprises sender authorization attributes including a connection address in the domain; and

finding at least one email display capability record for the domain further comprises finding, in dependence upon the domain identification and in dependence upon the connection address, at least one email display capability record for the domain.

4. The method of claim 1 further comprising the steps of:

receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object;

determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, wherein the determining results in a determination;

forwarding the email, including the digital object, to the email address, if the determination is that the digital object is not to be transcoded in the transcoding gateway; and

if the determination is that the digital object is to be transcoded in the transcoding gateway, carrying out the further steps of:

transcoding the digital object into a transcoded digital object; and

downloading the transcoded digital object to a destination client device.

5. The method of claim 4 wherein:

transcoding the digital object further comprises transcoding the digital object into a digital file having a digital format and a file name; and

downloading the transcoded digital object further comprises downloading the digital file to a destination client device at an internet address recorded in an internet address field of a client device record, the client device record having:

recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message, and,

recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file.

6. The method of claim 4 wherein determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, further comprises finding a capability record having a connection address equal to the email address.

7. The method of claim 4 wherein forwarding the email further comprises forwarding the entire email, including the digital object, to an email client in another transcoding gateway in a client device.

8. A system of email administration comprising:

means for receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;

means for finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and

means for sending at least one of the email display capability attributes to the sender.

9. The system of claim 8 wherein the email display capability request includes a sender identification identifying the sender, and the system further comprises means for determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain.

10. The system of claim 9 wherein means for determining that the sender is authorized to send email to a connection address in the domain further comprises means for finding, in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record, wherein:

the sender authorization record represents authorization for the sender to send email to a connection address in the domain;

the sender authorization record comprises sender authorization attributes including a connection address in the domain; and

means for finding at least one email display capability record for the domain further comprises means for finding, in dependence upon the domain identification and in dependence upon the connection address, at least one email display capability record for the domain.

11. The system of claim 8 further comprising:

means for receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object;

means for determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, wherein the determining results in a determination;

means for forwarding the email, including the digital object, to the email address, if the determination is that the digital object is not to be transcoded in the transcoding gateway; and

if the determination is that the digital object is to be transcoded in the transcoding gateway, means for carrying out the further steps of:

means for transcoding the digital object into a transcoded digital object; and

means for downloading the transcoded digital object to a destination client device.

12. The system of claim 11 wherein:

means for transcoding the digital object further comprises means for transcoding the digital object into a digital file having a digital format and a file name; and

means for downloading the transcoded digital object further comprises means for downloading the digital file to a destination client device at an internet address recorded in an internet address field of a client device record, the client device record having:

recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message, and,

recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file.

13. The system of claim 11 wherein means for determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, further comprises means for finding a capability record having a connection address equal to the email address.

14. The system of claim 11 wherein means for forwarding the email further comprises means for forwarding the entire email, including the digital object, to an email client in another transcoding gateway in a client device.

15. A computer program product of email administration comprising:

a recording medium;

means, recorded on the recording medium, for receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;

means, recorded on the recording medium, for finding, in dependence upon the domain identification, at least one email display capability record for the domain,

wherein the email display capability record for the domain comprises display capability attributes describing an email display capability for the domain; and

means, recorded on the recording medium, for sending at least one of the email display capability attributes to the sender.

16. The computer program product of claim 15 wherein the email display capability request includes a sender identification identifying the sender, and the computer program product further comprises means, recorded on the recording medium, for determining, in dependence upon the sender identification, that the sender is authorized to send email to a connection address in the domain.

17. The computer program product of claim 16 wherein means, recorded on the recording medium, for determining that the sender is authorized to send email to a connection address in the domain further comprises means, recorded on the recording medium, for finding, in dependence upon the sender identification and in dependence upon the domain identification, at least one sender authorization record, wherein:

the sender authorization record represents authorization for the sender to send email to a connection address in the domain;

the sender authorization record comprises sender authorization attributes including a connection address in the domain; and

means, recorded on the recording medium, for finding at least one email display capability record for the domain further comprises means, recorded on the recording medium, for finding, in dependence upon the domain identification and in dependence upon the connection address, at least one email display capability record for the domain.

18. The computer program product of claim 15 further comprising:

means, recorded on the recording medium, for receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object;

means, recorded on the recording medium, for determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, wherein the determining results in a determination;

means, recorded on the recording medium, for forwarding the email, including the digital object, to the email address, if the determination is that the digital object is not to be transcoded in the transcoding gateway; and

if the determination is that the digital object is to be transcoded in the transcoding gateway, means, recorded on the recording medium, for carrying out the further steps of:

transcoding the digital object into a transcoded digital object; and

downloading the transcoded digital object to a destination client device.

19. The computer program product of claim 18 wherein:

means, recorded on the recording medium, for transcoding the digital object further comprises means, recorded on the recording medium, for transcoding the digital object into a digital file having a digital format and a file name; and

means, recorded on the recording medium, for downloading the transcoded digital object further comprises means, recorded on the recording medium, for downloading the digital file to a destination client device at an internet address

recorded in an internet address field of a client device record, the client device record having:

recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message, and,

recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file.

20. The computer program product of claim 18 wherein means, recorded on the recording medium, for determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, further comprises means, recorded on the recording medium, for finding a capability record having a connection address equal to the email address.

21. The computer program product of claim 18 wherein means, recorded on the recording medium, for forwarding the email further comprises means, recorded on the recording medium, for forwarding the entire email, including the digital object, to an email client in another transcoding gateway in a client device.

22. A method of email administration comprising the steps of:

receiving in a transcoding gateway from a sender an email display capability request for a domain, wherein the capability request comprises a domain identification;

finding, in dependence upon the domain identification, at least one email display capability record for the domain, wherein the email display capability record for

the domain comprises display capability attributes describing an email display capability for the domain;

sending at least one of the email display capability attributes to the sender;

receiving an email in a transcoding gateway, the email comprising an email address and at least one digital object;

determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway;

forwarding the email, including the digital object, to the email address, if the digital object is not to be transcoded in the transcoding gateway; and

if the digital object is to be transcoded in the transcoding gateway, transcoding the digital object into a transcoded digital object and downloading the transcoded digital object to a destination client device.

23. The method of claim 22 wherein:

transcoding the digital object further comprises transcoding the digital object into a digital file having a digital format and a file name; and

downloading the transcoded digital object further comprises downloading the digital file to a destination client device at an internet address recorded in an internet address field of a client device record, the client device record having:

recorded in a mailbox address field in the client device record, a mailbox address identical to the email address of the email message, and,

recorded in a digital file format code field of the client device record, a digital file format code indicating that the client device represented by the client device record is capable of receiving the digital format of the digital file.

24. The method of claim 22 wherein determining, in dependence upon display capability attributes and the email address, whether the digital object is to be transcoded in the transcoding gateway, further comprises finding a capability record having a connection address equal to the email address.